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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,416	02/25/2004	Peter Gorski	02418.0875	9815
22852	7590	11/16/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CHIU, RALEIGH W	
		ART UNIT	PAPER NUMBER	
		3711		

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/785,416	GORSKI ET AL.	
	Examiner Raleigh Chiu	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 October 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.  
 4a) Of the above claim(s) 19-23 is/are withdrawn from consideration.  
 5) Claim(s) 4 is/are allowed.  
 6) Claim(s) 1-3,5-15,17 and 18 is/are rejected.  
 7) Claim(s) 16 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 July 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/25/2004</u> .	6) <input type="checkbox"/> Other: _____

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**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I ((claims 1-18) in the reply filed on 31 October 2005 is acknowledged.
2. Claims 19-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 31 October 2005.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

4. The drawings were received on 09 July 2004. These drawings are acceptable.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9-11, 13, 17 and 18 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

§112(2)

Regarding claims 9-11, 13, 17 and 18, "the front dampening element" lacks a proper antecedent basis.

With further regard to claim 11, "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

***Claim Rejections - 35 USC §§ 102 and 103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,663,515 (Pai)

Regarding claims 1 and 5, Figure 5 of Pai shows a racquet with a rear dampening sheet element 30 sandwiched between two composite handle layers 22,24.

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Regarding claim 3, Figure 1 shows the dampening element extending from the front of the handle to the rear.

11. Claims 1, 6, 7, 14, 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,685,583 (Severa et al., hereinafter Severa).

Regarding claims 1, 6, 7, 14, 15 and 18, Figure 3 of Severa show a polyurethane shell 26 surrounded by a rear dampening sheet material 40.

12. Claims 1 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,860,878 (You).

Regarding claims 1 and 17, Figure 6 of You shows dampening elements 46 that extend parallel to the stringing and correspond to the recited dampening sheets.

13. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,071,125 (Shen).

Figure 3 of Shen shows a racquet with a front dampener 50.

14. Claims 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pai as applied above in view of Shen.

Regarding claims 6, 7 and 9, Pai discloses the damping element to be a resilient material but fails to describe a specific material. See column 2, lines 13-30. However, it would have been obvious to use polyurethane (PU) in view of Shen who teaches that the use of PU is old and well-known in the

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tennis art as an elastic damping element; further, PU is well-known in the art to be foamed or thermoplastic.

15. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pai as applied above.

Regarding claim 8, the width and length of a typical racquet handle is considered to be at least 10 mm and 140 mm, respectively.

Regarding claim 12, discovering an optimum value of a result effective variable has been held to be within the capabilities of the person of ordinary skill in the art. It would have been obvious to a person having ordinary skill in this art, by routine experimentation, to provide the Pai dampener with the recited density range in order to obtain optimum vibration dampening.

#### ***Allowable Subject Matter***

16. Claim 4 is allowed.

17. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Primary Examiner  
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